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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,174	05/15/2001	Martyn Ian Butterworth	13344-9025-00	1570

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/858,174

Applicant(s)

BUTTERWORTH, MARTYN IAN

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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## **DETAILED ACTION**

### **Claim Status**

Applicant elects, without traverse, claims 1-8, 18-25 for prosecution on the merits after a restriction requirement, while claims 27-34 and 12-17 are canceled and claims 9-11 and 26 are being withdrawn. Applicant is herein requested to cancel the withdrawn claims in a future correspondence. The restriction is herein made final.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 (including its dependent claims) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Here, although the claim recites a method step, however, it appears that the claim at best reflects a system rather than a method. Thus, the claim is said to be indefinite or confusing. Applicant is herein being required to rewrite either as a proper method step comprising a plurality of steps or a proper system claim.

Claim 5 (including its dependent claims) is rejected under 35 USC 112(2) for being indefinite. Indeed, the claim recites the terms “**and/or**”. Here, it is unclear whether the limitation that follows “**and/or**” is preceded by “**and**” or “**or**”. For examination purpose, the Examiner assumes that the Applicant meant to refer to - **or** -.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 18-25 rejected under 35 U.S.C. 102(b) as being anticipated by Gregorek,  
**USP 5,428, 670**

As per claims 1-8 and 18-25, Gregorek discloses a marketing method and system for selectively modifying an existing communications network by modifying a portion of the processing software **that permits replacing at least a portion of a call progress signal (conventional signal or conventional message) generated by the communications network by a generally continuous pre-recorded announcement.** A first station is provided for placing a call by a calling party at a first network address. The network is adapted for connecting the call to an identified called station (called party) at a second network address, the called station having either a busy status or an idle status. The network initially determines the busy/idle status of the called station and, if the called station has an initial busy status, thereafter checks the busy/idle status of the called station at predetermined intervals. **A player plays at least one generally continuous announcement to the calling party for a predetermined period of time during a time period when a call progress signal would have been provided to the calling party (providing at least one pre-recorded/supplemental message or announcement in lieu of or in place of a call signal to a caller or calling party via an apparatus or calling device).** The player determines the announcement (audio message) to be played to the calling party

**based upon criteria established exclusively by the marketing system and independently of the identity of the called station.** The playing of the announcement is terminated and the call is completed to the calling station in the case of the calling station having an initial idle status, when the called station responds by answering the call. In the case of the called station having an initial busy status, the playing of the announcement is terminated and the call is completed when the status of the called station changes to an idle status and the called station thereafter responds by answering the call (See abstract).

In general, the present system relates to a communication marketing system and more particularly to a communications marketing system for selectively modifying a communications network by replacing at least a portion of an audible or visual call progress signal generated by the communications network by a pre-recorded announcement and by modifying a portion of the existing processing software of the communications network (col. 1: 13-19).

Furthermore, Gregorek discloses that it would be advantageous to have a communications network, which would replace the audible or visual ring-back and/or busy signals initiated by the communications network with **a series of pre-recorded announcements**, which would provide the calling party or caller **with useful information**. When a telephone or other device at the called network address or station line is answered, the announcements would discontinue and the connection would be completed in the usual manner. In addition, the announcements would be discontinued if the calling party abandons the communication or attempted communication. The pre-recorded announcements comprise a plurality of subject matters including publicity, promotions and advertisements (col. 1: 53 to col. 2: 19).

The communications network may be provided by private or publicly owned local exchange, inter-exchange, long distance, international, telecommunications, cable television, broadcast, switched, dedicated or hybrid types of network providers utilizing wireless facilities-based, satellite-based, or hybrid types of transmission schemes and/or mechanisms (col. 3: 19-27). In addition, while in the described embodiment, one or both of the telephone stations (calling and called) are illustrated as being typical or standard telephone instruments, the term "station" could refer to any device or object which may be connected to or be an integral part of a communication network to allow for the initiation, receipt and interaction of audio and/or visual information, including voice, data, video (image), multi-media, real time, store and forward, interactive or hybrid types of information (Here, the device or apparatus used by the caller is configured to play or display one or more announcements/messages, in lieu of a conventional signal, in the form of audio, audi/visual, video (image) and other type of multimedia related format Col. 3: 35-44).

Here, data relating to a specific pre-recorded announcement is transmitted from the storage device 102 of fig. 2 to the memory (not shown) located within or associated with the microprocessor 100 to enable processing of the announcements. The pre-recorded announcements are stored within the storage device 102 until the announcements are retrieved by the microprocessor 100 to be transmitted to the telephone station 12 of the calling party. **In the preferred embodiment, the message generator 16 also comprises a digital audio converter or card 106 and/or a video card (not shown) for containing digital pre-recorded advertisements, which can be transmitted to the telephone station 12 of the calling party, or if the calling party has a communication system having video capabilities such as a video**

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**telephone, video monitor 12a, television, set-top converter or other such device, a video announcement can be transmitted from the video card (col. 6: 61 to col. 7: 10).**

In the preferred embodiment, the message generator 16 first instructs the calling party to remain on the telephone 12 and informs the calling party that the call to the second telephone 20 will be attempted to be completed at regular intervals at block 54. Communication messages are passed between the message generator 16 and the network's call~12~ processing software system to determine the current status of the second ~2~telephone 20. Simultaneously, the message generator 16 determines the type of announcements that should be played and the order in which they will be played at block 56. The message generator 16 then preferably generates digitally stored advertisements, messages or announcements to the calling party at the first telephone 12 for a predetermined period of time at block 60. It is to be understood by those skilled in the art that any type of advertisement and/or message can be generated by the message generator 16. The information is translated to audio and/or video signals at block 61 (fig. 2: col. 9: 4-22).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,652, 784 to Blen discloses a telephone advertising service for providing a short advertising message through a telephone receiver as a telephone call is initiated. The advertising message is stopped after a predetermined run time, and an invitation-to-dial tone is added. The advertising message is stopped when a subscriber starts to dial numbers. The method provides

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the advertising messages in lieu of invitation-to-dial tones. Differentiated subscribers are individually provided with distinct advertising messages. Subscribers are distinguished by characteristics of exchange number, monthly call volume, call type, geographical location and time of day. The advertising messages are provided by a message system rack connected to a digital or analog telephone exchange. Each rack has plural message recorders and plural cards connected to multiple users. Software controls a

connection network. Subscriber lines are sampled to sense when a call is being initiated and to signal to a controller that a telephone call is being initiated. A PCM audio interface is activated. An available message channel is switched to the subscriber line, and a corresponding message is played over the subscriber line. Soon the subscriber line is connected to the telephone exchange, and an invitation-to-dial tone is provided. Several different messages are offered in different sets of channels, changing the messages depending on the time of day. When a prohibit service signal is active, the subscriber line is switched directly to the telephone exchange (See abstract).

USP 5,937,037A to Kamel discloses a telecommunications system for delivering promotional messages to subscribed calling parties. In one configuration, the system includes an association processor for comparing preset targeting criteria of each promotional message with profile data of each subscribed calling party to obtain data associating each of the promotional messages with at least one subscribed calling party. In addition, a message queue having a plurality of electronic queues is provided, each of the electronic queues assigned to at least one subscribed calling party and storing the data associating each of the promotional messages with at least one subscribed calling party. A call processor operates off-line of the association processor and accesses an



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electronic queue assigned to a calling party and delivers to the calling party a promotional message according the data contained in the accessed electronic queue. In a preferred configuration, multiple queue types are provided having differing targeting precisions.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

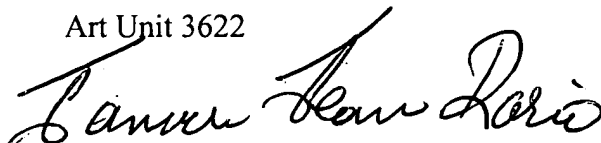
JDJ

12/26/07

Jean D. Janvier

Patent Examiner

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A handwritten signature in black ink, appearing to read "Jean D. Janvier", written in a cursive style.